

REMARKS

The Official Action dated January 2, 2003 has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration and allowance of all remaining claims is respectfully requested.

By the present amendment, claim 1 has been amended, claim 15 canceled and claim 40 has been added. Support for the amendments may be found, for example, in original claims 15 and Page 18, lines 1-5. Since these changes do not involve any introduction of new matter, entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner rejected claims 1-6, 9, 10, 12-17 and 39 under 35 U.S.C. §103 as being unpatentable over Brown et al. (U.S. Patent No. 6,071,566). The Examiner asserted that Brown et al. teach applying a mixture of silanes to a metal substrate in order to facilitate subsequent application of a paint layer. The Examiner noted that Brown et al. do not exemplify Applicant's composition, but teach using a two component aqueous mixture. The Examiner asserted it would be expected that the aqueous mixtures of silanes of Brown et al. would inherently contain some partially hydrolyzed groups. The Examiner asserted it would have been obvious to one of ordinary skill in the art to utilize a mixture of bis (trimethoxysilylpropyl) amine and vinyl silane as disclosed by Brown et al in order to effectively treat a metal substrate.

However, as will be set forth in detail below, it is submitted that the methods of claims 1-6, 9, 10, 12-17 and 39-40 are non-obvious over and patentably distinguishable from the teachings of Brown et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Brown et al. fail to teach or suggest the silane ratio of the presently amended claim 1. In fact, the teachings of Brown et al. are directly contrary to the silane ratios of claims 1, 39

and 40 of the present invention. Specifically, Brown et al. disclose that the preferred ratio of vinyl silanes to multi-silyl-functional silanes is 1:2. In contrast, Applicants have shown that, for mixtures of a vinyl silane and a bis-silyl aminosilane, the ratio is preferably at least about 1 (claim 1), more preferably at least about 4 (claim 39), and most preferably at least about 9 (claim 40).

References that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1132 (Fed. Cir. 1994). In addition, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Furthermore, to establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In view of the failure of Brown et al. to teach, disclose or suggest a ratio of vinyl silanes to bis-silyl aminosilane of at least 1, Brown et al. do not support a rejection of claims 1-6, 9, 10, 12-17 and 39-40 under 35 U.S.C. §103. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejection under 35 U.S.C. §103, and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

By



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